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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,441	04/02/2001	Richard Blankenbecler	S00-083	1790

30869 7590 08/26/2003

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
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PALO ALTO, CA 94306

EXAMINER

ZHOU, SHUBO

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 08/26/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/825,441

Applicant(s)

BLANKENBECLER ET AL.

Examiner

Shubo "Joe" Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 1-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 & 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Detailed Action

The art unit designated for this application has changed. Applicant(s) are hereby informed that future correspondence should be directed to Art Unit 1631.

Information Disclosure Statement

The Information Disclosure Statements filed 9/19/01 and 10/16/01 have been entered and considered. Initialed copies of the form PTO-1449 are enclosed with this action.

Claim Rejections-35 USC § 112

The following is a quotation of the **second** paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-18 are rejected under 35 U.S.C. 112 , second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 10 recite the limitation "said coordinates of said atoms of said first protein and said atomic coordinates of said atoms of said second protein" in steps (d), and (f)-(g) of each claim. There is insufficient antecedent basis for this limitation in the claim. No coordinates or atomic coordinates are recited before step (d) and thus, it is unclear what coordinates are meant in the claims.

Claims 2-9 and 11-18 are rejected due to their dependency from claim 1 or 10 and thus containing the indefinite limitation.

Clarification of the metes and bounds of the claims is requested.

Claim Objections

Claims 2-9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claims 2-9, as currently written, depend from claim 1. However, the claimed subject matter of claim 1 is “program storage device” whereas the claimed subject matter of claims 2-9 is a method. Thus, claims 2-9 cannot and do not further limit claim 1. Please be advised that applicants will be required to amend claims 2-9 to place the claims in better dependent form, or rewrite the claim(s) in independent form upon a finding of allowable subject matter.

Claims 1-18 are objected to because of the following informalities:

The phrase “comprising of” in claim 1 and its dependent claims 2-9 is inconsistent with the way it is commonly used. It is suggested that the claim be amended to delete the word “of” after “comprising”.

The meaning of steps (a) and (b) of claim 1 and 10 are not instantly clear. “Receiving a first protein with N1 atoms” or “receiving a second protein with N2 atoms” could mean receiving the protein substance in its physical form. Given that the claims involves computational methods and in light of the teachings in the specification, it is suggested that steps (a) and (b) be amended to recite “receiving the atomic coordinates of ...”.

Claims 2-9 and 11-18 are objected to due to their dependency from claim 1 or 10 and thus also containing the informalities.

Appropriate correction is required.

Claim Objections, Warning

Applicants are advised that should claims 10-18 be found allowable, claims 2-9 will be objected to under 37 CFR 1.75 as being substantial duplicates thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

In the instant case, since the claimed subject matter of claims 2-9 is the method set forth in claim 1, not the program storage device therein, and since the method in claim 1 comprises steps (a) through (i) that are identical to the method steps of claim 10, to which claims 11-18 depend, claims 2-9 are substantial duplicates of claims 11-18, respectively.

Conclusion

No claim is allowed.

However, it appears that the prior art does not teach or suggest a method of aligning protein structures involving application of mean field approach and energy functions including four energy costs, alone or together.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located

Art Unit: 1631

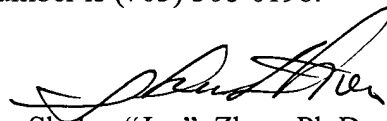
in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to:

Shubo "Joe" Zhou, Ph.D., whose telephone number is (703) 605-1158. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst Tina Plunkett whose telephone number is 703)-305-3524, or to the Technical Center receptionist whose telephone number is (703) 308-0196.



Shubo "Joe" Zhou, Ph.D.

Patent Examiner